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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,187	03/31/2004	Naoki Naruse	9683/185	7511
757	7590	09/19/2007		
BRINKS HOFER GILSON & LIONE			EXAMINER	
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CHICAGO, IL 60610				
			ART UNIT	PAPER NUMBER
			2163	
			MAIL DATE	DELIVERY MODE
			09/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/815,187

Applicant(s)

NARUSE ET AL.

Examiner

Hung T. Vy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-29 is/are pending in the application.
- 4a) Of the above claim(s) 5-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a response to Applicant's amendment filed 06/28/2007. In virtue of this amendment, claims 5-29 remain pending in this application of which claims 29 is newly added,

**Remarks on previous claims and newly added claim.**

2. Since applicant has received an action on the merits for originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 5-28 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142 (b) and MPEP 821.03.

3. The new added claim 29 is considered and examined in this office action since the claim 29 is the same the original claim 1 (now canceled).

4. For particular, the reason for restriction the claim 5-28 and original claims 1-4 (now canceled) or claim 29.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 5-28, drawn to an information-processing device for a mobile phone, classified in class 711, subclass 128.

II. Claim 29 (or claims 1-4, now canceled), drawn to an information-processing device, classified in class 707, subclass 100.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

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case, the combination as claimed does not require the particulars of the subcombination as claimed because combination, claims 5-28 do not comprises the particular details of such as estimating means, mean for reading contents instructed to be processed or executed from said cache memory mean, and mean for limiting means for limiting functions realized through processing or execution by said content using means on the basic of a determination of said determination means. It indicates that the combination (group I) does not rely upon the details of group II as discussed above. Further, the combination (Group I) is indicated as being used in a mobile phone (claims 14 and 26). The subcombination has separate utility such as and group II, subcombination has a separate utility such as prohibiting execution of the function and can be used in any other systems such as personal digital assistants or laptop computers.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Response to the Applicant's argument about the restriction, the Applicant's arguments are not persuasive because on section B, Claim 1 recites "are for trial use" and claim 5 recites "is for limited use" are different meaning. The trial use is trying something to find out about it and the limited use is restricted or place limits on using some thing to particular. Further, on section C, claim 1 recites, "to limit functions" and claim 5 recites "to prohibit execution" are different meaning. For particular, "limit functions" means to limit some function of content and "to prohibit execution" means command against absolute execution of the function of content. In section D, with the same of different meaning of claim 1 and 5 for example: claim 1 with "limit functions" is different "prohibit execution" of claim 5.

#### **Summary of claims**

6. Claims 5-29 are pending.

Claim 29 is rejected.

Claims 5-28 have been withdrawn from consideration as being directed to a non-elected independent and distinct from the invention originally claimed. The Applicant should cancel claims 5-28.

#### **Claim Rejections - 35 USC § 112**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, line 4, the phrase “ of said cache memory means, and content storage means for storing content” renders the claim indefinite because it does not fit into the context. It is also uncertain how cache memory means and content storage means are used with the rest of the elements and steps presented in the preamble of the independent claims.

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 29 is rejected under 35 U. S. C. § 102 (e) as being anticipated by Tanaka (U.S. Patent. 6,735,768).

With respect to claim 29, with best understood, Tanaka discloses an information processing device having cache memory means, acquiring means for acquiring contents which realize a function through processing or execution (column 2, line 10+, or column 3, line 40+), first writing means for writing contents acquired by the acquiring means in a free space or a space (26)(see column 4, line 28+), and it is inherent that where some data is already stored, of said cache memory means, and content storage means for storing contents because all computer has a cash to storing contents of frequency accessed RAM (see column 2, line 52) locations and the addressed where these data items are stored, said information processing device comprising: estimating means, when instructed to process or execute contents, for estimating whether said

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contents are for trial use (generating code D by performing an operation P)(S5)(see column 2, line 23+ or column 5, line 46+), by determining in which of said cache memory means and said content storage means said contents are stored (26)(see fig. 2 and column 6, line 4+, and line 27+); content using means for reading contents instructed to be processed or executed from said cache memory means or said content storage means (26) (see column 6, line 49), and processing or executing said contents; determining means, when contents are processed or executed by said content using means (what kind of generate code for this software)(lock, unlock) (see column 2, line 23+), for determining whether to limit functions realized through processing or execution of said contents, on the basis of an estimation of said estimating means and function limit information showing a rule (lock, unlock)(see column 2, line 23+) regarding limits on functions realized through processing or execution by said content using means (see column 2, line 23+); and limiting means for limiting functions realized through processing or execution by said content using means on the basis of a determination of said determining means (see column 2, line 23).

### **Response to Arguments**

9. Applicant's arguments filed on 06/28/2007 have been fully considered but they are not persuasive. Applicant made the following arguments:

- a. "In contrast, the Tanaka reference does not...in the software program to be executed" page 2.

**Examiner's remarks:**

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The Examiner does not agree with Applicant's argument above because Tanaka discloses determining means, when contents are process (Examiner asserts that when the user computer (1) install the software form software supplier computer (14), based on what kind software that computer (1) install, when the computer (1) executes the content (i.e., "the software S" was installed)), for determining when contents are process (i.e., "the software S was installed"), for determining whether to limit functions realized through processing or execution of said content (i.e., "The software product S may be locked by encrypting a part or the whole of the software product"(col. 2, line 33+)) so therefore, Tanaka discloses determining whether to execute a function in a program based on the type of function to be executed (i.e., "The software product S may be functionally limited by lock unlocked by the use of a key code K" (col. 2, line 23+)) (Examiner asserts that when the user computer (device) executes the software S, some function of computer (1) is limited) and further allow user computer (a device) access to various functions in a software program. Further, The applicant's argument is not support for the claim language. There is not "mobile phone (or other device)" controlling whether to allow certain functions in the software program to be executed" but Tanaka discloses based on the content (i.e., "software S"), controlling by using the encrypting to allow certain functions in the software program or device to be executed. Applicant has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 f.2d 1393, 1404-05, 162 USPQ 541, 550-51. Applicant is invited to bring limitations into the claim from specification to more clearly point out what the applicant feels is the invention to overcome the currently cited prior art.



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- b. “Moreover, the section in the Tanaka reference cited ...contend that the claims as currently presented are patentable over the cited art” pages 3-4.

**Examiner’s remarks:**

The Applicant’s argument is not persuasive because the claim does not support for the Applicant’s argument as “the electronic device”. Further, Tanaka discloses user computer (1)(fig. 2) is the electronic device, all limitation of claim, and further for security reason, Tanaka also discloses the authorized user and based on the authorization and software S for particular user, the device will have some limit function. Thus, the Tanaka reference teaches all limitations as claimed.

**Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

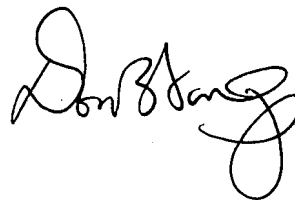
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Vy whose telephone number is (571) 272-1954. The

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examiner can normally be reached on Monday-Friday 8:30 am - 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-7722 for After Final communications.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either private Pair or Public Pair. Status information for unpublished applications is available through Private Pair only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy  
Art Unit 2163  
September 10, 2006.

A handwritten signature in black ink, appearing to read "Don Wong", is located in the lower right quadrant of the page. The signature is fluid and cursive, with the first name "Don" and last name "Wong" clearly distinguishable.

